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THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: RINDNER =1

In re Application of:) Art Unit: 2172
)
Yossi RINDNER) Examiner: C. Troung
)
Appln. No.: 10/091,393) Washington, D.C.
)
Date Filed: March 7, 2002) Confirmation No. 8666
)
For: SYSTEM AND METHOD FOR AUTOMATION OF ASIC...) September 30, 2004
)

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, **Mail Stop AMENDMENT**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

The applicant is in receipt of the Restriction Requirement Office Action mailed August 2, 2004. Applicant hereby replies, and attaches herewith a petition for one month's extension of time plus payment of the one month's late fee.

Restriction has been required between what the PTO deems to be two (2) patentably distinct inventions as outlined at the top of numbered page 2 of the Official Action. As applicant must make an election even though the requirement is traversed, applicant hereby respectfully and provisionally

elects Group II which the PTO says "is drawn to performing a stage in an ASIC design", with traverse and without prejudice.

First, applicant does not understand why claims 15 and 16 are not put into Group II rather than Group I. If the restriction requirement is to be maintained, applicant would request that claims 15 and 16 be included with the elected apparatus claims. Moreover, applicant believes that claims 15 and 16 are really "linking" claims which tie together the two groups. The presence of linking claims should by itself result in withdrawal of the requirement and examination of all the claims on the merits.

Another reason for traversal is that the reasons for the requirement given in the Office Action appear to be incorrect. First it is stated that inventions I and II "are related as sub-combinations disclosed as usable together in a single combination." Applicant simply does not understand this. Clearly, claims 1-5 are directed to a **method** and claims 6-14 are directed to an **apparatus**. How can it be validly said that these are sub-combinations usable together in a single combination?

Moreover, the PTO states that the inventions are "separately usable", but applicant does not see that this is so. Claim 1 relates to "a **method** for **interfacing between first and second successive stages of an ASIC synthesis tool**",

while claim 6 relates to **apparatus for interfacing between first and second successive stages of an ASIC synthesis tool**" (emphasis added). The script files automatically generated in accordance with claim 1 (referred to therein as "first script files") are the script files relating to each of the selectors of claim 6. Applicant considers that all the claims are related to the same invention.

Furthermore, there is still another reason why the requirement should be withdrawn, and in this regard applicant respectfully relies on the second paragraph of MPEP 803 which **requires** search and examination of an entire application (and this is so even in those cases where the restriction requirement is correct) if it would not constitute a "serious burden" to do so. Because of the close relationship between the method and apparatus as pointed out above, applicant respectfully submits and believes that it is clear that a complete search and examination of the elected claims of Group II cannot be conducted without searching and considering the parallel method claims of Group I, even if those Group I claims are separately classified.

The examiner is of course obligated to conduct a complete search, 37 CFR 1.104(a). Once the non-elected method has been considered and its location searched as required, it

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Amd. dated September 30, 2004
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clearly would not constitute a serious burden to examine the Group I claims.

Accordingly, for the many reasons given above, the restriction requirement should be withdrawn and all the claims should be examined on the merits. Such are respectfully requested.

Applicant now respectfully awaits the results of a first examination on the merits. Based on the prior art of which applicant is aware as noted in the IDS of record, applicant believes that the present claims are patentable and accordingly respectfully requests favorable consideration.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By



Sheridan Neimark
Registration No. 20,520

SN:jaa
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of Yossi RINDNER

Application No.: 10/091,556

Confirmation No.: 8666

Art Unit: 2172

Examiner: C. Troung

Filed: March 7, 2002

Washington, D.C.

For: SYSTEM AND METHOD FOR AUTOMATION OF ASIC...

Atty.'s Docket: RINDNER =1

Date: September 30, 2004

Customer Window, Mail Stop AMENDMENT

THE COMMISSIONER OF PATENTS AND TRADEMARKS

Crystal Plaza Two, Lobby, Room 1B03

Arlington, VA 22202

Sir:

Transmitted herewith is a [XX] REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

[] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

[XX] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.

[] No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1)	(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS ** 20	0
INDEP.	*	MINUS *** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM			

ADDITIONAL FEE TOTAL

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 43	\$
+ 145	\$
ADDITIONAL FEE TOTAL	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 86	\$
+ 290	\$
TOTAL	

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[XX] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [XX] First - \$ 55.00
- [] Second - \$ 210.00
- [] Third - \$ 475.00
- [] Fourth - \$ 740.00

Month After Time Period Set

[] Less fees (\$ _____) already paid for ____ month(s) extension of time on _____.

Other Than Small Entity

Response Filed Within

- [] First - \$ 110.00
- [] Second - \$ 420.00
- [] Third - \$ 950.00
- [] Fourth - \$ 1,480.00

Month After Time Period Set

[] Please charge my Deposit Account No. 02-4035 in the amount of \$ _____.

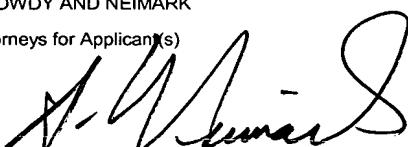
[XX] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ 55.00.

[] A check in the amount of \$ _____ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By: 
Sheridan Neimark
Registration No. 20,520

Facsimile: (202) 737-3528
Telephone: (202) 628-5197